

Appl. No. : 10/658,307
Filed : September 9, 2003

REMARKS

Amendments to the Specification

Applicants respectfully request entry of the Amendments to the Specification set forth above in which several minor typographical errors have been corrected by inserting -- μ --.

Claim Rejections - 35 U.S.C. § 103(a)

The claimed invention is not obvious because Wright teaches away from the combination proposed by the Examiner

The Examiner cites *In re Keller* and appears to have taken the position that Applicants' prior response attacked Jahng alone. See Office Action at 4. However, that response was specifically directed to the combination proposed by the Examiner. See Amendment filed October 20, 2005 at 10 ("Thus, Applicants respectfully submit that Wright *teaches away* from combining Jahng, Hisaya, Koblitz and applicant's purported admission in the manner indicated by the Examiner."). The Examiner has taken the position that it would have been obvious to a person of ordinary skill in the art to include the pendant group of Hisaya on the polysiloxane backbone of Jahng, thereby producing a polysiloxane that contains a chromophore (the pendant group of Hisaya). See Office Action mailed August 9, 2005 at 9.

However, Wright *teaches away* from such a combination by providing evidence that those skilled in the art understand that the T_g 's of polysiloxanes that contain chromophores are often undesirably low, leading to various problems. Wright notes that the polysiloxane 3 depicted in Scheme 1 "was found to have a T_g of 25°C, which is actually too low to be used with the concentrations of chromophore normally employed in photorefractive polymer composites. . . . This low T_g leads to fast phase separation of the chromophores in the polymer host and dielectric breakdown at small electric field strengths," see Wright at p. 4733, first column, second paragraph (emphasis added). "References cannot be combined where reference teaches away from their combination." M.P.E.P. § 2145(X)(D)(2).

The Examiner does not dispute that Wright teaches away from including a chromophore in a polysiloxane, but takes the position that "[h]ad a T_g been claimed, one of ordinary skill in the art at the time of the invention would have expected that the T_g of the Jahng, Hisaya, Koblitz and applicant's [purported] admission composition would inherently be the same as claimed and

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avoid the low T_g issue mentioned by Wright." Office Action at 4. However, even if that were to be established, it cannot be used as the basis for an inherency rejection. "[O]bviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." M.P.E.P. § 2141.02(V) (citing *In re Rijckaert*, 9 F.2d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993)).

Therefore, because Wright teaches away from the combination proposed by the Examiner and because the Examiner's inherency position is contrary to established law, Applicants respectfully request reconsideration and withdrawal of this rejection.

CONCLUSION

In view of foregoing Remarks, Applicants respectfully submit that this application is in condition for allowance, early notification of which would be appreciated. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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Dated: 12/21/05

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